

**REMARKS**

Claims 1-14 have been examined. Applicant amends claim 1-13 and cancels claim 14.

Therefore, claims 1-13 are all the claims pending in the application.

The amendments to claims 1 and 8 merely make explicit what was believed to have been implicit in the original claims 1 and 8, while the amendments to claims 2-7 and 9-13 simply correct minor informalities. Therefore, no estoppel is created.

**Reply to Examiner's Response to Arguments**

Applicant thanks the examiner for the Response to Arguments set forth in paragraph 3 of the Office action. However, applicant respectfully disagrees with the examiner's interpretation of page 2, line 20 through page 3, line 12 of applicant's specification. In particular, applicant respectfully disagrees with the examiner's conclusion that this portion of the specification constitutes admitted prior art and/or defines the pilot channel as being separate from a traffic channel and a control channel.

MPEP §2129 (8<sup>th</sup> Edition - revised February 2003) states that "[w]hen applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 611 (CCPA 1975) (Figures in the application labeled prior art held to be an admission that what was pictured was prior art relative to applicant's invention)."

In *Nomiya*, the applicants filed a patent application containing two figures labeled as “prior art” and described as such in the specification. *Id.* at 570-71, 184 USPQ at 611. The examiner rejected the pending claims as obvious over a U.S. patent in light of the two figures. *Id.* The applicants argued that the figures could not constitute prior art absent a statutory basis in section 102. The court stated “[b]y filing an application containing Figs. 1 and 2, labeled prior art, *ipsissimis verbis*, and statements explanatory thereof appellants have conceded what is to be considered as prior art in determining obviousness of their improvement.” *Id.* at 571, 184 USPQ at 611-12 (footnote omitted).

An admission is an acknowledgement that a fact or statement is true. (Merriam-Websters online - <[www.m-w.com](http://www.m-w.com)>). In the present application, the facts are clearly distinguishable from *Nomiya* (and other case precedent) in that nowhere in page 2, line 20 through page 3, line 12 of applicant’s specification, are admissions actually present.

For example, the examiner alleges that “Applicant admits ‘it has been proposed that a pilot channel be established in all areas from which the roaming radiotelephone may obtain the data necessary for reconfiguration.’” A mere “proposal” hardly qualifies as an admission to prior art and clearly lacks the details regarding implementation.

Assuming *arguendo*, that the examiner is correct, applicant’s discussion beginning on page 3 of the specification is applicant’s commentary on the proposition of establishing a pilot channel. However, this portion of the specification does not evidence or constitute an “admission.” Rather, applicant discloses his own considerations, such as bandwidth and standardization, relating to the establishment of a pilot channel.

As disclosed by applicant, “[a] pilot channel of this type, however, *will require* a relatively large bandwidth to allow a sufficiently fast transfer of the data required.” (Emphasis added). This sentence is an assertion by applicant, not an admission. Further, it is understood that applicant is commenting on the fact that the proposed pilot channel would be used to download the re-programming data (i.e., a channel of large bandwidth).

The examiner also alleges that “Applicant further admits ‘since the pilot channel is provided separately from a traffic channel used for transferring voice data and a control channel for performing control operations inherent to the particular network....’” Again, this sentence is an assertion by applicant, not an admission, in that if a pilot channel is added, it could be implemented as a separate channel.

In view of the above discussion, applicant respectfully submits that the examiner misinterprets this portion of the specification and incorrectly concludes what constitutes admitted prior art.

#### **Rejection of Claims 1-3 and 7-10 under 35 U.S.C. § 102(a) - Shah**

The examiner rejects claims 1-3 and 7-10 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,029,065 (hereinafter Shah). Applicant respectfully traverses this rejection.

Applicant incorporates the arguments presented in the Amendment filed April 16, 2003 on page 5, with respect to the teachings of Shah. Shah relies on air-interface standards, such as Interim Standards 95, where control channels are utilized for the allegedly corresponding

downloading of re-programming data. Shah, specifically discloses that paging and access channels are control channels per IS-95 specifications. (Col. 8, lines 56-58 of Shah). Thus, Shah fails to teach or suggest the claimed first dedicated channel that is “a pilot channel that is a channel separate from a traffic channel and a control channel,” as recited in claim 1.

For at least these reasons, applicant respectfully requests that the rejection of claim 1 be withdrawn. Claims 2, 3 and 7 are patentable at least by virtue of their dependency on claim 1.

Independent claim 8 includes a similar recitation, and for analogous reasons, is patentable over Shah. Claims 9-10 are patentable at least by virtue of their dependency on claim 8.

#### **Rejection of Claims 4-6 and 11-14 under 35 U.S.C. § 103(a) - Shah**

The examiner rejects claims 4-6 and 11-14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shah. Applicant respectfully traverses this rejection.

Shah fails to render obvious independent claims 1 and 8 for at least the reasons provided above. Claims 4-6 and 11-14 are patentable at least by virtue of their dependency on claims 1 and 8, respectively.

#### **Rejection of Claim-14 under 35 U.S.C. § 103(a) – Shah, APA**

The examiner rejects claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shah, in view of admitted prior art (APA). Applicant respectfully traverses this rejection.

While this rejection is rendered moot since claim 14 is cancelled, applicant further addresses the combination of Shah and APA with regard to claims 1 and 8.

Applicant's incorporate by reference herein applicants remarks set forth in the Reply to Examiner's Response to Arguments with respect to the alleged APA.

Further, even if, assuming *arguendo*, that the examiner is correct in that a pilot channel, separate from a traffic channel or a control channel is APA, the grounds of rejection fail to set forth why one skilled in the art would have modified Shah to include such a pilot channel. Indeed, assuming *arguendo*, that the paging channel of Shah corresponds to the claimed first dedicated channel, there would be no reason to add another channel to the system that would use additional bandwidth of the network or substitute the paging channel of Shah with a pilot channel.

## Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111  
U.S. Application No. 09/245,354

Attorney Docket No. Q53197  
Art Unit 2631

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Stan Torgovitsky  
Registration No. 43,958

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: December 10, 2003